PATENT
Customer No. 22,852
Attorney Docket No. 06502.0225

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)
	)
David John Martin PATTERSON	) Group Art Unit: 2195
	)
Application No.: 09/259,589	) Examiner: K. Tang
	)
Filed: March 1, 1999	) Confirmation No. 5471
	)
For: COMPUTER RESOURCE	)
MANAGEMENT FOR	)
COMPETING PROCESSES	)

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Commissioner for Patents
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the Final Office Action mailed March 8, 2005. This Request is being filed concurrently with a Notice of Appeal.

I.   **Requirements For Submitting a Pre-Appeal Brief Request for Review**

Applicant may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicant concurrently files the Request with a Notice of Appeal prior to filing an Appeal Brief; and (3) Applicant submits a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005.

Applicant has met each of these requirements and therefore requests review of the Examiner's rejections in the Final Office Action of March 8, 2005 ("Final Office Action") for the following reasons.

II. The Rejection of Claims 1-21 Under 35 U.S.C. § 112, Second Paragraph, is Improper

The Examiner alleged, with respect to claim 1, that "call duration value associated with the second process" and "communication" is indefinite because it is not "made explicitly clear in the claim language whether this call is a communication with an operating system call or a telephone call." Final Office Action, ¶ 5(a).

Claim 1 recites:

A resource manager operable to control allocation of a resource to competing computing processes including at least a first process and a second process, the resource manager being responsive to identification of a thread for the first process requesting allocation of the resource, when the resource is already allocated to a thread for the second process, to establish a joining function to the thread for the second process and to provide an indication to the first process of an expected time before the resource will become available determined based on a call duration value of a communication associated with the second process, the first process retrying requesting of the resource at a later time based on the indication,

wherein the joining function is operable to notify the resource manager on termination of the thread for the second process, and the resource manager is operable in response to termination of the thread for the second process to allocate the resource to the thread for the first process.

Despite the Examiner's insistence that claim 1 is indefinite, the claim is specifically directed to communication calls (e.g., claim 1 recites "a call duration value of a communication.") Generally, a call as it relates to an operating system call is a programming statement that requests services from another subroutine or program. On the other hand, a call as it relates to communications is different and refers to an action taken by a transmitting station to establish a connection with a receiving station.

The M.P.E.P. specifies that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." M.P.E.P. § 2173.02. Further, "[d]efiniteness of claim language must be analyzed, not in a vacuum, but in light of," among other things, "[t]he content of the particular application disclosure," and "[t]he claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the

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invention was made." *Id.* Here, it is clear that one of ordinary skill in the art would realize that a communications call, as it relates to Applicant's disclosure, refers to an action taken by a transmitting station to establish a connection with a receiving station. The term "communication" is well established in this field of endeavor. As such, it is improper for the Examiner to use Section 112, second paragraph as a tool to require Applicant to unnecessarily limit the above noted claims by adding language specifying whether a call "is a communication with an operating system call or a telephone call." Further, the mere fact that the Examiner allegedly has difficulty determining what type of call is recited in these claims does not meet the requirements for rejecting the claims under 35 U.S.C. § 112, second paragraph. "In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph." *Id.*

The Examiner also alleged, with respect to claim 1, that the phrase "the first process retrying requesting of the resource at a later time based on the indication" is indefinite "because it is unclear in the claim language why requesting even needs to be retried." Final Office Action, ¶ 5(b). The Examiner's position is based both on clear legal and factual errors. Legally, as the Applicant pointed out in the Request for Reconsideration, there is no requirement that a claim must "explain" or "describe" why certain limitations are present in the claim. *See* Request for Reconsideration, p. 4. This is the function of the specification. *Id.* Factually, the Examiner is not even correct in his allegation that it is unclear in the claim language why requesting even needs to be retried. Claim 1 specifically recites, at lines 4-5, that the retrying occurs "when the resource is already allocated to a thread for the second process."

III. The Examiner Did Not Establish a *Prima Facie* Case of Obviousness in Rejecting Claims 1-21 Under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03. In rejecting claims 1-21 under 35 U.S.C. § 103(a), the Examiner admitted that neither *McDonough et al.* nor *Simor* teach "the first process retrying requesting of the resource at a later time based on the indication." Final Office Action, ¶ 9. In an attempt to satisfy

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this deficiency, the Examiner alleged that *Serpanos* teaches this feature, and that it would have been obvious to combine the feature taught by *Serpanos* into the resource manager of *McDonough et al.* in view of *Simor. Id.* As explained in the Request for Reconsideration, *Serpanos* does not teach or suggest the missing recitations as asserted by the Examiner. *See* Request for Reconsideration, pp. 6-7.

For example, as noted in the Request for Reconsideration, the Examiner pointed to the concept of a "waiting time" taught by *Serpanos* to allege a teaching of an "indication to the first process of an expected time before the resource will become available determined based on a call duration value of a communication associated with the second process," as recited in claim 1. *See* Request for Reconsideration, p. 6. The "waiting time" of *Serpanos* is a predetermined time that a <u>requester</u> will wait for a resource before requesting use of the resource again, and is dependent on the characteristics of the requestor. *See Serpanos*, col. 6, lines 39-44. However, claim 1 recites an "indication" that depends "on a call duration value of a communication associated with the second process," which means that the claimed indication relates to characteristics of an entity that already has use of the resource, <u>not a requestor</u>. *See* Request for Reconsideration, p. 7. It follows that requesting an additional service based on "waiting time" as taught by *Serpanos* does not constitute the claimed "retrying requesting of the resource at a later time based on the indication," because this claimed feature specifies "requesting" <u>the use of a resource</u> based on a characteristic of an entity <u>other than the requestor</u>. *See id.* Requesting an additional service based on "waiting time," however, is essentially the requesting of a service based on a characteristic of the requestor itself. *See id.*

In response to Applicant's arguments, the Examiner issued an Advisory Action on June 14, 2005 ("Advisory Action") maintaining the rejection of claims 1-21 in view of the cited art. The Examiner, however, did not address any of the above-referenced arguments pertaining to the cited art, which are directed toward the rejection's lack of showing of a *prima facie* case of obviousness. Instead, the Examiner commented solely on the arguments set forth by the Applicant that pertain to the rejections under 35 U.S.C. 112, second paragraph. *See* Advisory Action, ¶ 11. Accordingly, the Examiner has not provided comments or reasons why the cited art, taken alone or in combination,

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teaches or suggest each and every element of claims 1-21, as refuted by Applicant in the Request for Reconsideration. As such, neither the rejection, nor the Examiner's comment in the Advisory Action, meet the requirements for establishing a *prima facie* case of obviousness.
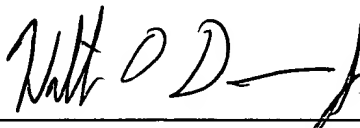
III.   Conclusion

In light of the above arguments and those presented in the Request, Applicant submits that the Examiner, in rejecting claims 1-21 failed to establish that the claims are indefinite and failed to establish a *prima facie* case of obviousness. Therefore, the rejection of these claims under 35 U.S.C. §§ 103(a) and 112, second paragraph, should be withdrawn and the claims allowed.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
    GARRETT & DUNNER, L.L.P.

Dated: September 8, 2005   By: _____

Walter D. Davis, Jr.
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